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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,346	12/30/2003	Daniel F. Justin	13447.40	8202
22913	7590	11/03/2005	EXAMINER	
WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER & SEELEY) 60 EAST SOUTH TEMPLE 1000 EAGLE GATE TOWER SALT LAKE CITY, UT 84111			STEWART, ALVIN J	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

88

Office Action Summary	Application No. 10/749,346	Applicant(s) JUSTIN ET AL.	
	Examiner Alvin J. Stewart	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-51 is/are pending in the application.
- 4a) Of the above claim(s) 16, 17, 25, 33-37, 41, 44, 49 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 15, 18-24, 26-28, 32, 38, 40, 42, 43 and 45-47 is/are rejected.
- 7) ☒ Claim(s) 29-31, 39, 48 and 50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/26/05; 7/18/05</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Applicant's election without traverse of Group II, Species I and Sub-species A in the reply filed on September 26, 2005 is acknowledged.

Claims 16, 17, 25, 33-37, 41, 44, 49 and 51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 26, 2005.

Regarding claims 35 and 37, these two claims depend on a withdrawn claim. Therefore, the claims have not been examined.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 14, 18-20, 22, 26-28, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Zile et al US Patent 5,019,103.

Van Zile et al discloses a condyle implant comprising a bearing plate (22) having a top articular surface (24) and an opposing bottom surface (62), a stem (48) downwardly projecting from the bottom surface of the bearing plate and means for connecting (see Figs. 1, 3 and 4) a fastener (50) to the stem.

Regarding claim 18, see Fig. 1.

Regarding claim 19, see col. 6, lines 53-55.

Regarding claim 22, the term integral was held not to be limited to a fabrication of the parts from a single piece of material, but was inclusive of other means of maintaining the parts fixed together as a single unit. In re Larson et al., 340 F 2d 965, 144 U.S.P.Q. 347 (C.C.P.A. 1965). The word “integral” is sufficiently broad to embrace constructions united by such means as fastening and welding. In re Hotte, 475 F 2d 644, 177 U.S. P.Q. 326 (C.C.P.A. 1973).

Claims 14, 21-24, 26-28, 38, 46 and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Albrektsson et al US Patent 6,102,954.

Albrektsson et al discloses a condyle implant comprising a bearing plate (30) having a top articular surface and an opposing bottom surface, a stem (20) downwardly projecting from the bottom surface of the bearing plate and means for connecting (threaded-spiral surface) a fastener (21) to the stem. The stem is removably encircling at least a portion of the fastener (see Fig. 10).

Claims 14, 15, 22, 26, 27, 38, 40 and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Ek US Pub. 2004/0106928.

Ek discloses a condyle implant comprising a bearing plate (20) having a top articular surface (31) and an opposing bottom surface, a stem (21) downwardly projecting from the bottom surface of the bearing plate and means for connecting a fastener (22) to the stem.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 3738

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 42, 43 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albrektsson et al US Patent 6,102,954 in view of Van Zile et al US Patent 5,019,103.

Albrektsson et al discloses the invention substantially as claimed. However, Albrektsson et al does not disclose a pocket and an inlay having a porous bone ingrowth material, a fastener having a length in a range between about 5mm to about 15mm and an enlarged crown nut removably mountable to the fastener.

Van Zile et al discloses an implant comprising a bearing plate having at least one pocket and an inlay with a porous bone ingrowth material in order to promote the growth of bone following implantation (see col. 6, lines 51-55).

Regarding claim 43, Albrektsson et al discloses the claimed invention except for the teaching of a fastener having a length in a range between about 5mm to about 15mm. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have a length range between about 5mm to about 15mm, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the enlarged crown with an enlarged head formed on the shaft because Applicant has not disclosed that by having an enlarged crown provide an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform

Art Unit: 3738

equally well with the head of the Albrektsson et al reference because the head of the Albrektsson reference would perform equally as well as the Applicant's enlarged crown.

Therefore, it would have been an obvious matter of design choice to modify the Albrektsson et al reference to obtain the invention as specified in claim 45.

Allowable Subject Matter

Claims 29-31, 39, 48 and 50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin J. Stewart whose telephone number is 571-272-4760. The examiner can normally be reached on Monday-Friday 7:00AM-5:30PM(1 Friday B-week off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/749,346

Page 6

Art Unit: 3738

A. Stewart

**ALVIN J. STEWART
PRIMARY EXAMINER**

Art Unit 3738

October 28, 2005.